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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/656,258 | 09/06/2000 | JIMMIE D. BURROW | B-68826 | 9092 |

7590 05/06/2003

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| EXAMINER | |
|---|---|
| CHAN, SING P | |
| ART UNIT | PAPER NUMBER |
| 1734 | |

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/656,258 | BURROW ET AL. |
| | Examiner | Art Unit |
| | Sing P Chan | 1734 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2,8-26,29 and 30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,8-26,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 September 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroda (U.S. 4,160,685).

Regarding claims 1 and 15, Kuroda discloses a method of forming an appliqué article. The method includes the steps of providing a foam plastic sheet member of thermoplastic material such as polyvinyl chloride, providing an imaged sheet of polyvinyl chloride by printing on the first surface of the imaged sheet, superimposed the sheet member and imaged sheet onto a base sheet, and bonding and indenting the member and the imaged sheet with a heating platen using high frequency, i.e. RF energy. (Col 3, lines 49-62, Col 4, lines 36-59)

Regarding claim 30, Kuroda discloses a method of forming an appliqué article. The method includes the steps of providing a foam plastic sheet member of thermoplastic material such as polyvinyl chloride, providing an imaged sheet of polyvinyl chloride by printing on the first surface of the imaged sheet, superimposed the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure

with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines 36-59) The process of superimposing the sheet member and imaged sheet in the bonding step is considered to satisfy the recited step of placing the imaged sheet onto the debossing die and placing the member in engagement with the imaged sheet.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 8-10, and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) as applied to claim 1, and further in view of Aitkens et al (U.S. 5,380,044).

Regarding claims 2 and 13, Kuroda as discloses above in the 102(b) rejection is silent as printing multiple image on a larger imaged sheet and cutting the imaged sheet from a larger imaged sheet prior to placing the imaged sheet onto the sheet member. Aitkens et al discloses a method of forming an identification card. The method includes printing the identification layouts on a larger vinyl laminate, i.e. larger imaged sheet, and cutting out the individual card layout prior to placing the imaged sheet onto the substrate, i.e. sheet member. (Col 10, lines 3-33)

It would have been obvious to one skilled in the art at the time the invention was made to print a number of images onto a larger sheet and cutting the imaged sheet into

individual sheets as disclosed by Aitkens et al in the method of Kuroda to allow easy handling and storage of the imaged sheet until needed.

Regarding claim 8, Kuroda disclosed printing image on the image sheet and the sheet is translucent, i.e. opaque. (Col 4, lines 52-59) However, Kuroda is silent as to the printing comprises of inkjet printing, photostatic printing, and thermal ribbon printing. But these printing methods are well known and convention to one in the art shown by the availably of inkjet printers, laser printers, and thermal ribbon printers and also by Aitkens et al. Aitkens et al discloses the printing of the imaged sheet by video color printer, which is considered to be an ink jet printer.

It would have been obvious to one skilled in the art at the time the invention was made to print the images on a larger sheet material to form multiple image sheets with inkjet printer, photostatic printer, or thermal ribbon printer as disclosed by Aitkens et al in the method of Kuroda wherein the printer are readily available and easily used and also prevent unnecessary waste of the sheet material.

Regarding claim 9, Kuroda as disclosed in the above 102(b) rejection is silent as to the image printed on the imaged sheet is provided by scanning and copying an image source and transferring to the printer. However, scanning and copying an image from an image source is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the optical scanner to scanning any graphical design, i.e. image, and transferring to the processor and outputting the final image to the printer. (Col 5, lines 5-10 and Col 7, lines 9-12)

It would have been obvious to one skilled in the art at the time the invention was made to provide an optical scanner as disclosed by Aitkens et al in the method of Kuroda to easily copy and scan any image into a processor for printing.

Regarding claim 10, Kuroda as disclosed in the above 102(b) rejection is silent as to applying an ink receptive coating to the image sheet. However, applying an ink receptive coating onto a plastic image sheet is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the image sheet is coated with an ink absorbing material. (Col 8, lines 4-32)

It would have been obvious to one skilled in the art at the time the invention was made to coat the image sheet with an ink receptive coating as disclosed by Aitkens et al in the method of Kuroda to allow better adhesion of the ink to the image sheet.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044) as applied to claim 10 above, and further in view of Lu et al (U.S. 5,891,552).

Kuroda as modified above does not disclose providing a texture prior to applying a coating. However, one in the art would appreciate treating the plastic film prior to coating to allow better adhesion of the coating to film and such treatment, which would provide a texture surface is well known and conventional. For example, Lu et al discloses the film is treated with flame or corona treatment to provide a high energy surface for better adhesion of the coating or primer and is considered to provide textured surface. (Col 7, lines 1-7)

It would have been obvious to one skilled in the art at the time the invention was made to treat the surface of the film as disclosed by Lu et al in the method of Kuroda to provide a high energy surface to allow better adhesion of coating and primer.

6. Claims 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044) as applied to claims 1, 2, and 13 above, and further in view of Jenkins (U.S. 5,974,230).

Kuroda as modified above is silent as to providing a clear polyvinyl chloride cover sheet over the larger image sheet. However, providing a polyvinyl chloride cover sheet over a larger imaged sheet is well known and conventional as shown for example by Jenkins. Jenkins discloses a clear vinyl cover sheet with a pressure sensitive adhesive is laminated to the larger image sheet prior to die cutting to individual labels. (Col 2, lines 65-66, Col 4, lines 49-54, and Figure 2)

7. Claims 17, 19, 20, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044).

Regarding claims 17 and 25, Kuroda discloses a method of forming an appliqué article. The method includes the steps of providing a foam plastic sheet member of thermoplastic material such as polyvinyl chloride, providing an imaged sheet of polyvinyl chloride by printing on the first surface of the imaged sheet, superimposed the sheet member and imaged sheet onto a base sheet, and bonding and indenting the member and the imaged sheet with a heating platen using high frequency, i.e. RF energy. (Col 3, lines 49-62, Col 4, lines 36-59) Kuroda is silent as to transferring an image to a processor and outputting the image to a printer, printing multiple images on a larger

imaged sheet and cutting the imaged sheet from a larger imaged sheet prior to placing the imaged sheet onto the sheet member. Aitkens et al discloses a method of forming an identification card. The method includes transferring images into a C.P.U., i.e. a processor, outputting the images to a color printer, printing the identification layouts on a larger vinyl laminate, i.e. larger imaged sheet, and cutting out the individual card layout prior to placing the imaged sheet onto the substrate, i.e. sheet member. (Col 6, line 60 to Col 7, line 49 and Col 10, lines 3-33)

It would have been obvious to one skilled in the art at the time the invention was made to transfer the image to a processor, outputting the image to a printer, print a number of images onto a larger sheet and cutting the imaged sheet into individual sheets as disclosed by Aitkens et al in the method of Kuroda to allow faster and easier handling and storage of the image and imaged sheet until needed.

Regarding claim 19, Kuroda discloses superimposing the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines 36-59) The process of superimposing the sheet member and imaged sheet in the bonding step is considered to satisfy the recited step of placing the imaged sheet onto the debossing die and placing the member in engagement with the imaged sheet.

Regarding claim 24, Kuroda discloses the member sheet is indented, i.e. debossed, as the imaged sheet is bonded to the member sheet. (Col 3, line 53 to Col 4, line 15)

Regarding claim 26, Kuroda is silent as to applying an ink receptive coating to the image sheet. However, applying an ink receptive coating onto a plastic image sheet is well known and conventional as shown for example by Aitkens et al. Aitkens et al discloses the image sheet is coated with an ink absorbing material. (Col 8, lines 4-32)

It would have been obvious to one skilled in the art at the time the invention was made to coat the image sheet with an ink receptive coating as disclosed by Aitkens et al in the method of Kuroda to allow better adhesion of the ink to the image sheet.

8. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Kaule (U.S. 5,817,205).

Kuroda does not disclose debossing the sheet member to form a guide device prior to placing the image sheet onto the substrate for bonding. However, debossing a substrate to form a guide device to aid in guiding an imaged sheet for bonding is well known and conventional as shown for example by the Kaule. Kaule discloses a method of applying a hologram to a paper substrate. The method includes running the paper substrate into a glazing unit with cylinders with raised areas to produce indented surface, applying bonding agent to the glazed stripe or stripes and applying an endless hologram, which is guided to the glazed stripe or stripes. (Col 9, lines 25-46 and Figure 2 and 3)

It would have been obvious to one skilled in the art at the time the invention was made to emboss or deboss the member sheet to provide indentation on the sheet

member as disclosed by Kaule in the method of Kuroda wherein the indentation would provide a guiding and positioning mean to properly place the an image sheet or film.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Pargh (U.S. 2,602,560).

Kuroda as modified above does not disclose directing a light beam on a predetermined location on the sheet member for guiding the placement of the imaged sheet. However, providing a light beam on the article or substrate to direct the placement of sheet or label is well known and conventional as shown for example by Pargh. Pargh discloses a labeling machine. The labeling machine includes a number of light rays from light sources, which provided spots or focus points on the surfaces of the article and indicate the exact point a label is to be placed. (Col 13, line 64 to Col 14, line 15)

It would have been obvious to one skilled in the art at the time the invention was made to provide light beams to aid in directing the placement of the imaged sheet onto the sheet member as disclosed by Pargh in the method of Kuroda to allow fast and easy placement of the imaged sheet and proper align the imaged sheet on the die.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Aitkens et al (U.S. 5,380,044) as applied to claim 17 above, and further in view of Jenkins (U.S. 5,974,230).

Kuroda as modified above does not discloses laminating a transparent sheet of polyvinyl chloride over the imaged sheet. However, laminating a transparent sheet of

polyvinyl chloride over the imaged sheet is well known and conventional as shown for example by Jenkins. Jenkins discloses a method of forming labels. The method includes providing a clear vinyl cover sheet is laminated over the printed sheet prior to die cutting into individual image sheets. (Col 4, lines 47-54)

It would have been obvious to one skilled in the art at the time the invention was made to provide a transparent polyvinyl chloride sheet over the imaged sheet as disclosed by Jenkins in the method of Kuroda to protect the image on the imaged sheet from damage.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (U.S. 4,160,685) in view of Kaule (U.S. 5,817,205).

Kuroda discloses a method of forming an appliqué article. The method includes the steps of providing a foam plastic sheet member of thermoplastic material such as polyvinyl chloride, providing an imaged sheet of polyvinyl chloride by printing on the first surface of the imaged sheet, superimposed the sheet member and imaged sheet with the second side facing the sheet member onto a base sheet in the bonding die, and bonding and indenting the member with heat and pressure with a heating platen using high frequency, i.e. RF, energy. (Col 3, lines 49-62, Col 4, lines 36-59) Kuroda does not disclose debossing the sheet member to form a guide device prior to placing the image sheet onto the substrate for bonding. However, debossing a substrate to form a guide device to aid in guiding an imaged sheet for bonding is well known and conventional as shown for example by the Kaule. Kaule discloses a method of applying a hologram to a paper substrate. The method includes running the paper substrate into

a glazing unit with cylinders with raised areas to produce indented surface, applying bonding agent to the glazed stripe or stripes and applying an endless hologram, which is guided to the glazed stripe or stripes. (Col 9, lines 25-46 and Figure 2 and 3)

It would have been obvious to one skilled in the art at the time the invention was made to emboss or deboss the member sheet to provide indentation on the sheet member as disclosed by Kaule in the method of Kuroda wherein the indentation would provide a guiding and positioning mean to properly place the an image sheet or film.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 2, 8-26, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 703-305-3175. The examiner can normally be reached on Monday-Friday 7:30AM-12:00PM and 1:00PM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sing P Chan
Examiner
Art Unit 1734

spc
May 2, 2003

RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700